

**REMARKS:**

The following remarks are submitted as a full and complete response to the Office Action issued on August 21, 2008. Claims 1-9 are pending and claims 4-6 are withdrawn after the election made May 9, 2008. Accordingly, claims 1-3 and 7-9 are under examination.

**Rejections under 35 U.S.C. §102**

The Office has rejected claims 1, 3 and 7-9 under 35 U.S.C. §102(e) as allegedly being anticipated by U.S. Patent Application No. 2006/0207938 to Kim, et al. ("Kim I"). Applicants respectfully disagree.

As the Office correctly acknowledged, the foreign priority date of the current application is July 5, 2003. However, the 102(e) date of Kim I is February 11, 2004, which is later than the priority date of the present application. Thus, Applicants respectfully submit that Kim I does not qualify as prior art against the present application under 35 U.S.C. §102(e), which warrants withdrawal of this rejection.

The Office has further rejected claims 1, 3 and 7-9 under U.S.C. §102(a) as allegedly being anticipated by Jon et al., JACS 125:10186-10187, 2003 ("Jon"). Applicants respectfully traverse this rejection.

As set forth in the attached declaration by the inventors of the present application (unexecuted), the teachings of Jon indicated to be relevant to the claimed invention in the Office Action, are the inventors' own work. See Exhibit A, Declaration (unexecuted). In more detail, the three authors of Jon who are not listed as inventors of the present application—Soo-Young Kim, Young Jin Jeon and Jae Wook Lee—did not make any inventive contribution to the inventions claimed in claims 1, 3 and 7-9. The executed Declaration will be supplemented. Thus, Jon

describes the inventors' own work and cannot constitute prior art with respect to the rejected claims. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Rejections under 35 U.S.C. §103**

Claims 1, 2 and 7-9 have been rejected under 35 U.S.C. §103(a) as allegedly obvious over U.S. Patent 7,388,099 to Kim, et al. ("Kim II") in view of U.S. Patent Application 2004/0147396 Richter, et al. ("Richter"). Applicants respectfully disagree.

Kim II and the claimed inventions were, at the time the claimed invention was made, owned by or subject to an obligation to assignment to, the same entity, POSTECH Foundation. Under 35 U.S.C. 103(c), if the subject matter developed by another, that is, the disclosure of Kim II and the claimed invention were, at the time the claimed invention was made, owned by or subject to an obligation to assign to the same person, the former is disqualified as prior art against the claimed invention.

MPEP states that

[t]he following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s): Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

MPEP 703.02(l)(2)II (citing "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (December 26, 2000)).

MPEP further explains that "[t]he applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and

reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO." *Id.* (emphasis added).

Following the MPEP, Applicants hereby make the statement of common ownership of the claimed invention and Kim II in a separate page which is attached hereto as Exhibit B.

Relying on the statement of common ownership as set forth in the attachment, Applicants respectfully submit that Applicants have clearly and conspicuously established that the claimed invention and Kim II were, at the time of the claimed invention, owned by or subject to an obligation to assignment to, the same entity, POSTECH Foundation. Thus, under 35 U.S.C. §103(c), Kim II is disqualified as prior art against the claimed invention. Richter, without Kim II, cannot establish a *prima facie* case of obviousness. Accordingly, the current rejection becomes moot under 35 U.S.C. §103(c). Applicants respectfully request withdrawal of this rejection.

### **Double Patenting**

Claims 1 and 3 have been provisionally rejected as unpatentable under obviousness-type double patenting over claim 3 of copending Application No. 10/544,850. In view of the provisional nature of this rejection, Applicants will address this rejection once allegedly conflicting claims are in fact patented.

In light of the foregoing, Applicants submit that all outstanding rejections have been overcome, and the instant application is in condition for allowance. Thus, Applicants respectfully request early allowance of the instant application. The Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-2135.

Respectfully submitted,

By: \_\_\_\_\_



Patrick T. Skacel  
Registration No. 47,948  
Attorney for Applicants  
ROTHWELL, FIGG, ERNST & MANBECK  
1425 K. Street, Suite 800  
Washington, D.C. 20005  
Telephone: (202) 783-6040